REMARKS/ARGUMENTS

This Amendment is prepared in response to an Office Action dated February 24, 2005. In the Office Action, claims 20-27 and 29-57 were rejected under 35 U.S.C. §103(a). Claim 25 has been amended. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, at a minimum, the combined teachings of the cited references do not describe or suggest sufficient motivation to modify the cited references and do not describe all the claim limitations.

A. §103(A) REJECTION OF CLAIMS 20, 23-25, 27, 29, 32-34, 36-38, 48-51

Claims 20, 23-25, 27, 29, 32-34, 36-38, 48-51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lawler (U.S. Patent No. 5,758,259) in view of Cave (U.S. Patent No. 4,045,816).

First, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills,* 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Applicants respectfully submit that Lawler is directed to an automated selective programming guide while Cave is directed to a noise corrective system. None of the cited references, either implicitly or explicitly, suggests the combination of counter circuitry used for noise correction with programming guide technology. In fact, Applicants respectfully submit that this combination may constitute impermissible use of non-analogous art or impermissible hindsight reconstruction.

With respect to non-analogous art, the Federal Circuit has previously determined that, in deciding whether prior art was non-analogous, it is necessary to use "common sense. *See In re Oeticker,* 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In accordance with the CCPA analysis, the determination involves (i) a determination if the reference is within the field of the inventor's endeavor. If it is not, a second determination is made whether the reference is reasonable pertinent to the particular program with which the inventor was involved. *See In re Wood,* 599 F.2d 1032, 202 U.S.P.Q. 171 (CCPA 1979). Herein, the teachings of Cave are not in the same field of the inventor's endeavor, but instead, are directed to the elimination, or at least the mitigation of fixed pattern odd/even noise and cell clock noise. Such teachings have no pertinence to maintaining relative statistics on one or more items related to the tuning event in order to accurately create a list of favorites based on these statistics as claimed.

Secondly, even if the combination of Lawler and Cave is deemed by the Examiner or the Board of Appeal to be permissible, the combination does not render the claimed invention

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unpatentable. The Examiner relies on the teachings in Cave of a 4-bit (max 15) counter (121), counting the number of rows of photosensor cells scanned, as suggestion of maintaining relative statistics through prevention of rollover. If the number of counts is greater than 10, the counter (121) is reset at disable gate (120). As a result, the counter appears to operate as a counter from zero "0" to ten "10", then reverting back to "0". Such teachings do not maintain the relative statistics as claimed, but instead, contribute to the same problems associated with rollover in which statistics (counts) for favorites are reset without maintaining the current count order before being reset.

Hence, Applicant respectfully submits that independent claims 25, 34, 37 and 49 as well as those claims dependent thereon are in condition for allowance.

B. §103(A) REJECTION OF CLAIMS 21, 30 AND 39

Claims 21, 30, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Cave and Perlman (U.S. Patent No. 5,583,576). Claims 21, 30 and 39 depend on claims 25, 34 and 37, respectively. Thus, these claims are allowable based on their dependency on allowable claims. Applicant respectfully reserves the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

C. §103(A) REJECTION OF CLAIMS 22, 31, AND 46

Claims 22, 31, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Cave and Levitan (U.S. Patent No. 5,534,911). Claims 22, 31 and 46 depend on claims 25, 34 and 37, respectively. Thus, these claims are allowable based on their dependency on allowable claims. Applicant respectfully reserves the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

D. §103(A) REJECTION OF CLAIMS 26, 35, AND 47

Claims 26, 35, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Cave and Zahavi (U.S. Patent No. 5,410,367). Claims 26, 35 and 47 depend on claims 25, 34 and 37, respectively. Thus, these claims are allowable based on their dependency on allowable claims. Applicant respectfully reserves the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

E. §103(A) REJECTION OF CLAIMS 40-42 AND 53-54

Claims 40-42 and 53-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Cave and Graves (U.S. Patent No. 5,410,344). Claims 40-42 and 53-54 depend on claims 37 and 47, respectively. Thus, these claims are allowable based on their dependency on allowable claims. Applicant respectfully reserves the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

F. §103(A) REJECTION OF CLAIMS 43-44 AND 55-57

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Claims 43-44 and 55-57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Cave e and Hooley (U.S. Patent No. 6,373,955). Claims 43-44 and 55-57 depend on claims 37 and 47, respectively. Thus, these claims are allowable based on their dependency on allowable claims. Applicant respectfully reserves the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

G. §103(A) REJECTION OF CLAIM 52

Claim 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Cave and Amano (U.S. Patent No. 5,323,240). Claim 52 depends on claim 47. Thus, these claims are allowable based on its dependency on allowable claim 47. Applicant respectfully reserves the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

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Conclusion

At the Examiner's earliest convenience, Applicant respectfully requests withdrawal of the outstanding rejections and issuance of a Notice of Allowance. As always, the Examiner is invited to contact the undersigned attorney at the phone number listed below if further discussion will facilitate prosecution of the subject application.

Respectfully submitted,

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